

REMARKS

Claims 1-10 and 30-48 are pending in the present application. In the Office Action mailed July 17, 2007, the Examiner rejected claims 1-10 and 30-48 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner next rejected claims 1-10 and 30-48 under 35 U.S.C. §103(a) as being unpatentable over Buddle et al. (USP 6,912,502) (hereinafter Buddle) and Official Notice.

The Examiner rejected claims 1-10 and 30-48 under §112, second paragraph. Applicant respectfully disagrees. In particular, the Examiner alleged that the following limitations were indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention: claim 1, lines 3, 5, and 7; claim 39, line 3; and claim 40, lines 5, 12-13.

Regarding the alleged indefinite rejections the Examiner stated that, in claim 1, it is not clear what constituents direct sales processes nor what comprises current policy compliance. First, Applicant directs the Examiner to element “a)” of claim 1, which does not call for “current policy compliance.” That is, the term “current” was removed from claim 1.

Second, “is not indefinite if the meaning of the claim term is discernible.” *MPEP* §2173.02. The Specification discloses at least designing an electronic transactions system and forming a proposal for doing business on a global communications network. The Examiner is referred to the Specification at page 3 (entire page), page 5 first full paragraph, page 5 last paragraph, page 6 first full paragraph, page 14 first full paragraph, page 15 first paragraph and accompanying drawings, page 23 second paragraph, page 23 third paragraph and the respective drawings, page 25 second paragraph with reference to Fig. 7, and page 36 last paragraph with reference to Fig. 15. One skilled in the art would understand what constitutes “direct sales processes” and what comprises “current policy compliance” as they relate to businesses. As such, Applicant believes claim 1, line 3 is not indefinite.

The Examiner stated that the terms “new screening processes” and “minimize commercial risk” in claim 1, line 5 were indefinite. Applicant disagrees. One skilled in the art would discern that “new screening processes” constitutes processes developed that address issues relevant to the unique electronic marketplace. Likewise, one skilled in the art will understand what comprises “minimize commercial risk” as it relates to a business proposing to do business on a global communications network. Accordingly, Applicant believes claim 1, line 5 is not indefinite.

Claim 1, line 7 calls for integrating the existing direct sales screening processes and new screening processes. The Examiner stated that it “is not clear as to what constitutes integrating.” *Office Action*, 07/17/07, pg. 16. Applicant respectfully disagrees. One skilled in the art will know what the term “integrating” means. Accordingly, Applicant believes claim 1, line 7 is not indefinite.

Regarding claim 36 the Examiner stated that it is not clear as to what constitutes applicable regulations. However, again, the claim does not call for what the Examiner indicated it calls for. Instead, claim 36 calls for considering impact of regulatory regulations on electronic sales transactions. Accordingly, the rejection of claim 36 under §112, second paragraph, is unclear, and Applicant requests withdrawal thereof.

With regard to claim 40, the Examiner stated that it is not clear as to what constitutes “prohibited transaction criteria.” Certainly, one skilled in the art will readily recognize that such would constitute transaction criteria that is prohibited. The Examiner is referred to the Specification for teaching. For example, page 15 first paragraph, page 18 second paragraph, page 32 last paragraph, paragraph bridging page 33-34, and page 36 first paragraph.

With reference to claim 40, the Examiner stated “it is not clear as to what constitutes such criteria” with respect to the act to “determine legal terms and conditions to associate with the medical device sales request.” The language is clear and simple. It clearly satisfies the requirements of 35 U.S.C. §112. In this case, the computer is programmed to determine the appropriate legal terms and conditions with the medical device sales requests as clearly set forth in the Specification. For example, the Examiner is referred to the paragraph bridging pages 1-2, page 3 first paragraph, page 3 second paragraph, page 4 second paragraph, page 4 third paragraph, page 5 first paragraph, page 6 first full paragraph, page 13 first full paragraph, page 15 last paragraph, page 16 first paragraph, page 18 second paragraph, page 18 third paragraph, page 19 third paragraph, page 19 fourth paragraph, page 21 second paragraph, etc. and accompanying drawings.

In light of the foregoing, Applicant respectfully requests withdrawal of the §112, second paragraph rejection of claim 1-10 and 30-48.

The Examiner has rejected claim 1-10 and 30-48 under §103(a) as being unpatentable “in view of Buddle and Official Notice.” *Office Action*, 07/17/2007, pg. 17. Applicant respectfully disagrees.

The Examiner took Official Notice “that the subject matter from claims 1-10 and 30-48 appears to be common knowledge business attributes.” *Office Action*, 07/17/2007, pg. 17

(emphasis added). Despite the ambiguity of the above statement, Applicant disagrees and demands that the Examiner produce authority for this statement.

To begin, it is unclear as to what the Examiner is stating. On its face, the Examiner is stating that the subject matter appears to be common knowledge. With this in mind, the Examiner then combines the Buddle reference with an appearance of common knowledge to show obviousness. Applicant respectfully questions the Examiner's logic.

First, the subject matter of claims 1-10 and 30-48 are not and do not have the appearance of common knowledge. In part, it is the manner in which the claims 1-10 and 30-48 elucidate the invention that makes the subject matter of each claim not well-known in the art -- thus, not common knowledge.

Next, the use of the term "appears" does not ring of a qualifier to a statement that is "capable of such instant and unquestionable demonstration as to defy dispute." MPEP §2144.03A; *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961). That is, if the subject matter of the claims merely appears to be instantly demonstrable, then it is clearly not instantly demonstrable. Either it is or it isn't. Since the Examiner hasn't clearly identified that the subject matter is instantly demonstrable, then a *prima facie* case of Official Notice has not been established, and the subject matter of all claims are not shown to be well-known.

Additionally, "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." *Id*; *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. It is true that the Examiner has used the Official Notice with the reference Buddle to allege obviousness. However, the obvious rejection including Buddle appears to be form-over-substance since the Examiner had already asserted that all subject matter was common knowledge under Official Notice and since no showing as to how Buddle applies to specific elements of the claims has been made. Accordingly, it seems that the Buddle reference is merely ancillary to the principle evidence upon which the rejection was based under Official Notice in light of the fact that the Examiner has taken Official Notice of twenty-eight (28) claims, two of which were independent claims, while only relying on Buddle to show that existing regulations, laws, statutes, internal standards or policies, and other sources of compliance requirements are reviewed and posted on the Internet. The Examiner has taken Official Notice of approximately over one-hundred (100) elements.

Accordingly, Applicant respectfully requests the withdrawal of the Official Notice. If the Official Notice is not withdrawn, Applicant demands that the Examiner produce authority for what is officially noticed.

The Examiner has additionally relied on a reference that is not available as prior art in the obviousness rejection; therefore, the rejection should be withdrawn. The Application claims the benefit of prior U.S. Provisional Application Serial No. 60/168,893 filed December 3, 1999 and entitled TOOL KIT FOR DEVELOPING AN INTERNET-BASED RESTRICTED TRANSACTION SYSTEM, and such benefit is referenced on the first page of the application. *Specification*, pg. 1. As such, the effective filing date of the Application is December 3, 1999, which predates the reference: filed on December 30, 1999. *See* §706.02. Therefore, Buddle is not available as prior art.

Accordingly, Applicant respectfully requests withdrawal of the §103(a) rejection to claims 1-10 and 30-48.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-10 and 30-48.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-0845. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-0845. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 07-0845. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 07-0845.

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